



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/540,478

Art Unit: 3644

Filing Date: June 23, 2005

Examiner: Trinh Nguyen

Applicant: Nils Erik HOLMERTZ et al. Conf.: 2985

Title: METHOD AND APPARATUS FOR COUNTING
SOMATIC CELLS OF FAT DROPLETS IN MILK

Attorney Docket: 19200-000049/US

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REASONS FOR REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Conferees:

In response to the Final Office Action mailed on May 4, 2009 ("Final OA"), Applicants request that a Pre-Appeal Brief Review Conference review the pending rejections under 35 U.S.C. § 112, paragraph 1 for lack of enablement, the rejection under 35 U.S.C. § 112, paragraph 2 for indefiniteness, and the various rejections under 35 U.S.C. § 103(a). The Reasons for Pre-Appeal Brief Request for Review are being filed concurrently with the Pre-Appeal Brief Request for Review and a Notice of Appeal. Claims 1-38 are pending in the current application and claims 1-23, 25-27, 32, and 35-38 currently stand rejected.

I. THE EXAMINER USES THE WRONG STANDARD FOR ENABLEMENT.

Initially, please see Applicants' arguments traversing this rejection in the amendment filed on January 30, 2009, pp. 12-13. With regard to independent

claim 1, the Examiner alleges that the amended claim term “recording about 1000 or more two-dimensional digital images” is not enabled because it lacks support in the original specification. Final OA at 2. Applicants respectfully submit that support in the original specification is the test for the written description requirement, not for the separate enablement requirement. See MPEP § 2161 (“The written description requirement is separate and distinct from the enablement requirement”). Enablement is instead based on whether a person skilled in the art would be *able to practice and understand the claim terms* based on the specification and *their knowledge in the art*. See MPEP §§ 2164 & 2173. Thus, the enablement rejection is not ready for appeal at least because the Examiner is using the wrong legal standard for the rejection.

Applicants further direct the conferees to paragraphs [0039] and [0042] of the specification as published (page 11, line 17 through page 12, line 14 of the specification as filed) for a description of recording “a large number, e.g., thousands, of images.” The surrounding discussion describes how the large number of images facilitates recordation of accurate milk characteristics and lists specific equipment capable of recording the thousands of images for this purpose. In light of the specification's disclosure of methodology, equipment, and purpose for recording thousands of milk images, coupled with knowledge of the relevant art, one would be able to “record about 1000 or more two-dimensional digital images” as recited in claim 1. Under the correct standard for enablement, Applicants have reasonably disclosed how to practice the recited recording step, and the rejection under 35 U.S.C. § 112, first paragraph

for lack of enablement to claims 1-23, 25-27, 32, and 35-38 is further not ready for appeal.

II. THE CLAIMS ARE DEFINITE UNDER THEIR PLAIN LANGUAGE, LET ALONE IN LIGHT OF THE SPECIFICATION.

Initially, please see Applicants' arguments traversing this rejection in the amendment filed on January 30, 2009, pp. 12-13. The Examiner alleges that "repeatedly recording about 1000 or more two-dimensional digital images" is indefinite because it lacks support in the original specification and the terms "about" and "more" make the claim unclear. Final OA at 2. Applicants respectfully submit that use of the term "about" in claims is specifically condoned by caselaw and the MPEP. *See, e.g.*, MPEP § 2173.05(b)(A). Claims may recite ranges using a minimum value with no upper bound or by the term "or more" without being indefinite. *See, e.g.*, MPEP § 2173.05(c)(II). Applicants also direct the conferees to the discussion and cited portions of the specification above, teaching a person skilled in the art how to record a number of images sufficient to achieve accurate results at the disclosed image resolutions in example methods. In light of the use of approved, clear claim language with a specific, ascertainable scope based on the teachings of the specification, the claims are definite, and the rejection under 35 U.S.C. § 112, second paragraph to claims 1-23, 25-27, 32, and 35-38 is not ready for appeal.

III. NONE OF THE APPLIED REFERENCES TEACH OR MAY BE MODIFIED TO RECORD SEVERAL DIGITAL IMAGES.

Initially, please see Applicants' arguments traversing this rejection in the amendment filed on January 30, 2009, pp. 13-15. The Examiner admits that

the applied references do not teach “recording about 1000 or more two-dimensional digital images” of illuminated milk as recited in every claim. Final OA at 4. The Examiner alleges that the use of about 1000 or more images is nothing more than discovery of an optimum or workable range from the general conditions disclosed in US Pat 6,731,100 to Hansen et al. (“Hansen”). Id.

Applicants respectfully submit that Hansen’s disclosure of a **maximum of 4 digital images** is not within a general condition for **about 1000 or more digital images**. See Hansen, Col. 5, ll. 53-58. Cases and guidance in the MPEP discussing discovery of optimum ranges rely on applications claiming values wholly encompassing or **within an order of magnitude** of the values in the applied art. See MPEP § 2144.05(II). The values of 4 and 1000 are **over two orders of magnitude apart**. Thus, Hansen does not disclose the general conditions that may be optimized under relevant § 103 standards.

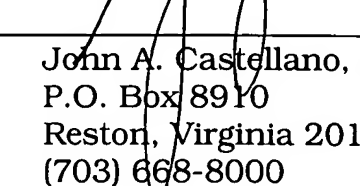
Worse, even if Hansen and the claimed values were anywhere near a shared general condition, Hansen explicitly teaches away from the claimed range. See Hansen, Col. 5, ll. 53-58 (“in some cases just a few exposures such as two, three, or four exposures, **but the by far preferred embodiment is to use just one exposure**”). Teaching away rebuts any prima facie case of obviousness by optimality. See MPEP 2144.05(III) (“Applicant can rebut a presumption of obviousness based on a claimed invention that falls within a prior art range by showing that the prior art taught away from the claimed invention”). Thus, Hansen teaches away from the claimed ranges and cannot be used in a rejection under § 103 to the same.

US Pat 6,694,830 to Hakes ("Hakes") and US Pat 3,367,416 to Van Der Lely et al. ("Van Der Lely") do not cure the disclosure and suggestion deficiencies of Hansen discussed above. Specifically, Hakes and Van Der Lely are silent with regard to digital images entirely, let alone a number to be recorded. Because Hansen, alone or in combination with Hakes and Van Der Lely, fails to teach or suggest "recording about 1000 or more two-dimensional digital images" recited in every claim, the rejection under § 103 based on these references is not ready for appeal.

CONCLUSION

In view of the above, Applicants respectfully request that the Conference consider and reverse the current rejections and either allow the present application or reopen prosecution in connection with the present application. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
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